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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Decathlon

Serial No. 74/485,941

Virgil H. Marsh of Fisher, Christen & Sabol for
Decathlon.

Andrew J. Benzmilller, Trademark Examining Attorney, Law
Office 116 (Adam Striegel, Acting Managing Attorney).

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Decathlon, a French company, has filed an
application to register the mark DECATHLON on the
Principal Register for the following goods¹:

¹ Serial No. 74/485,941 was filed on February 3, 1994 in several classes based on an allegation of a bona fide intention to use the mark in commerce, under Section 1(b) of the Trademark Act. Applicant included a claim of priority, under Section 44(d) of the Trademark Act, based upon an application filed in France on August 10, 1993. After filing its

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Precious metals and their alloys and goods in precious metals or coated therewith, not included in any other classes, namely, horological and chronological instruments, namely, clocks, chronometers, cufflinks, tie pins, and sun dials, in International Class 14;

Typewriter paper, staples for offices, drawing pens and pencils, pencil sharpeners, pencils, rubber erasers, card and document files, wall calendars, and adhesive tape dispensers, in International Class 16; and

Carpets, rugs, plastic bath and doormats and matting, and carpets for automobiles and artificial turf, in International Class 27.

The trademark examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the marks identified below, previously registered, respectively, for the indicated goods, that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

With respect to applicant's goods in International Class 14, the examining attorney has cited Registration No. 892,450 for the mark

appeal, applicant divided several classes out of this "parent" application into two "child" applications, Serial Nos. 75/978,041 and 75/980,161; and deleted its Section 1(b), intent-to-use, filing basis (except with respect to services in International Class 41, which is no longer in this application). This application includes a photocopy of a French registration, although its date of submission is not specified and it is unclear whether the examining attorney has considered it. If applicant should ultimately prevail in this appeal, the file should be returned to the examining attorney to consider the photocopy of the French registration.

DECATHLON for "bracelets, including watch bracelets."²

With respect to applicant's goods in International Class 16, the examining attorney has cited Registration No. 1,870,515 for the mark DECATHLON for "desk top accessories, namely, desk paper trays, desk calendar trays and pen and pencil holders."³

With respect to applicant's goods in International Class 27, the examining attorney has cited Registration No. 1,365,708 for the mark DECATHLON for "floor tiles of plastic composition."⁴

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested.

Upon taking up this appeal for final decision, the Board conducted a status search of the cited registrations. Cited Registration Nos. 892,450 and 1,870,515 have been canceled and/or expired. The refusal to register under Section 2(d) of the Act based on these registrations with respect to applicant's goods in International Classes 14 and 16, respectively, is moot.

² Registration No. 892,450 issued June 9, 1970, to Textron, Inc. This registration has been canceled and expired, respectively, under Sections 8 and 9 of the Trademark Act.

³ Registration No. 1,870,515 issued December 27, 1994, to Westinghouse Electric Corporation. This registration has been cancelled under Section 8 of the Trademark Act.

⁴ Registration No. 1,365,708 issued October 15, 1985, to American Biltrite Inc. Sections 8 and 15 affidavits accepted and acknowledged, respectively.

Therefore, the only issue remaining in this appeal is the Section 2(d) refusal pertaining to the goods in International Class 27, which we now consider.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Considering, first, the marks, there is no question that applicant's mark and the mark in the cited registration are identical. Further, there is no evidence in the record indicating that DECATHLON is other than an arbitrary and strong mark with respect to applicant's goods and registrant's goods.

Thus, we turn to consider the goods involved in this case. The examining attorney contends that applicant's

and registrant's goods are closely related because "both goods are types of hard-surface synthetic floor coverings"; that there are no limitations on the channels of trade or classes of purchasers, so that the goods are presumed to travel through all normal trade channels to all usual purchasers; and that, in view of the identity of the marks, there is a sufficient relationship between applicant's and registrant's goods to support a finding of likelihood of confusion. In support of his position, the examining attorney cited two cases involving purportedly similar goods wherein the Board found a likelihood of confusion. *West Point-Pepperell, Inc. v. Congoleum Industries, Inc.*, 197 USPQ 191 (TTAB 1997); and *R.H. Macy & Co., Inc. v. Kentile, Inc.*, 138 USPQ 486 (TTAB 1963).⁵

Applicant contends that applicant's and registrant's goods have different uses, and travel through different channels of trade because the goods are sold in different areas or departments of stores. In particular, applicant states that carpets for automobiles and artificial turf are entirely different products from plastic tiles; that

⁵ Applicant correctly argues that each case must be decided on its facts, and, therefore, the two cases cited by the examining attorney must be distinguished on their facts and cannot be the basis for finding the goods involved herein to be similar.

a rug may be placed over a tile floor, but the products serve different purposes; and that plastic tiles are adhered to a floor, whereas the other identified products are not adhered to a floor.

The question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate

from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

As the examining attorney stated, it is well established that when the marks at issue are the same or nearly so, the goods in question do not have to be identical to find that confusion is likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983), ". . . the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion."

Neither the examining attorney nor applicant submitted any evidence in support of their respective positions regarding the relationship between applicant's and registrant's identified goods. However, the examining attorney has the burden of establishing the relationship between these goods and their channels of trade and classes of purchasers.

There is no question that the goods in both the application and registration are broadly identified and contain no limitations with regard to channels of trade

or classes of purchasers. The trade channels of the identified goods by their very nature encompass wholesale distribution and retail sales, and the purchasers thereof encompass the general consumer and the construction trade, among other trade channels and purchasers. In this regard, there is likely to be an overlap in the trade channels of applicant's goods and registrant's goods, at least as sold at retail in home improvement centers or department stores to general consumers. While the possibility that the respective goods may be sold in different sections of a store would be a factor to consider in determining the relationship between the goods, there is no evidence in the file establishing this as a fact and we will not presume it to be the case.

Considering applicant's goods as identified, we find no basis on this record to find a relationship between applicant's "plastic bath and door mats and matting," "carpets for automobiles" or "artificial turf" and registrant's "floor tiles of plastic composition" that is close enough for the use of the same mark with both to be likely to result in confusion. The fact that each product covers a surface, albeit different surfaces, is of slight significance in the absence of any evidence

that consumers would expect these different products to emanate from the same or a related source.

However, carpets, rugs and floor tiles, regardless of composition, are floor coverings that may be used for the same purposes in homes or business premises to cover entire floors or parts of floors, and may be used together, with carpets and rugs being placed on floor tiles. We find these products to be sufficiently related that, if identified by the identical marks involved in this case, confusion as to source would be likely. We are not persuaded otherwise by applicant's argument that tiles are adhered to a floor whereas carpets and rugs are not. First, this is not entirely true because wall-to-wall carpeting is, clearly, permanently installed and rugs and smaller carpets are likely to be "adhered" to a floor by various means to avoid slippage. Further, there is no basis in this record to conclude that consumers would distinguish between the two identical DECATHLON marks and the likely source of the respectively identified goods based on the method of installation of the goods.

Therefore, we conclude that in view of the identity of applicant's mark and registrant's mark, their contemporaneous use on carpets and rugs, on the one hand,

and plastic floor tiles, on the other hand, would be likely to cause confusion as to the source or sponsorship of such goods. To support a refusal, under Section 2(d) of the Act, with respect to the goods in International Class 27, it is only necessary to find a likelihood of confusion with respect to one of the goods in that class.

Finally, while our finding of likelihood of confusion is subject to some doubt because of the lack of evidence in the record, we resolve that doubt in registrant's favor. It is well established that one who adopts a mark similar to the mark of another for the same or related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988).

Decision: The refusal under Section 2(d) of the Act is affirmed.